

REMARKS

Claims 1-4, 6-9, 11, 13-15, 17-21, and 73-75, 77-104 are pending in this application. Claims 3, 4, 6, 7, 9, 11, 13-15, 17-21, 73-75, and 77-88 were previously withdrawn from consideration. Claims 1 and 89 have been amended. No new matter is added by these amendments.

Rejection under 35 U.S.C. § 103

Claim 89 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Xu et al.* (Org. Lett., 4(23):4021-4024, 2002). This rejection is based on the Office Action's assertion that this journal article, which is co-authored by Glenn Prestwich and Yong Xu, is prior art under 35 U.S.C. § 102(b). The rejection is addressed individually in view of claim 1 and new Claim 89.

Claim 89 as amended is identical to original claim 1 of the provisional application with the exception that Z in formula I is only CF₂. Provisional Application No. 60/462,095, from which the instant application claims the benefit under 35 U.S.C. § 119(e), was filed April 9, 2003. As pending claim 89 has support in the provisional application, it receives the benefit of the priority date of April 9, 2003. The publication date of *Xu et al.* is August 6, 2002. Therefore, with respect to claim 89, *Xu et al.* is not prior art under 102(b). In the Response dated March 12, 2009, the inventorship of the present invention was amended so that the authorship of *Xu et al.* was identical to the inventorship of the present invention. In view of the change of inventorship, *Xu et al.* is also not prior art under 35 U.S.C. § 102(a) to claim 89. Therefore, claim 89 cannot be obvious based on the disclosure of *Xu et al.* For at least this reason, applicant respectfully requests the rejection be withdrawn.

Rejections under 35 U.S.C. § 112

The Office Action rejected claim 1 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action notes that claim 1 was amended to recite that two R¹ variables form cycloalkyl or heterocycloalkyl group, which according to the Office Action does not find support in the instant specification. In

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order to advance prosecution, Applicants have amended claim 1 to delete this embodiment from the claim. In view of the amendments applicant respectfully requests the rejection be withdrawn.

CONCLUSION

Pursuant to the above amendments and remarks, reconsideration and allowance of the pending application is believed to be warranted. The Examiner is invited and encouraged to directly contact the undersigned if such contact may enhance the efficient prosecution of this application to issue.

No additional fee is believed to be due; however, the Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment to Deposit Account No. 50-1513.

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Respectfully submitted,

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In accordance with 37 C.F.R. § 1.8, I hereby certify that this correspondence, including any items indicated as attached or included, is being transmitted via electronic transmission via EFS-Web on the date indicated below

/Lawrence A. Villanueva/
Lawrence A. Villanueva

March 3, 2010
Date